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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/372,380 08/11/99 CHIEZ

R 08191/008003

HM22/1212

JANIS K FRASER  
FISH & RICHARDSON PC  
225 FRANKLIN STREET  
BOSTON MA 02110-2804

EXAMINER

ZHOU, S

ART UNIT	PAPER NUMBER
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1631

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DATE MAILED:

12/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/372,380	CHICZ ET AL.
Examiner	Art Unit	
Shubo "Joe" Zhou	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_\_ .

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-42 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims 1-42 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some \* c) None of the CERTIFIED copies of the priority documents have been:

1. received.

2. received in Application No. (Series Code / Serial Number) \_\_\_\_\_ .

3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

#### Attachment(s)

15) Notice of References Cited (PTO-892)                  18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)                  19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .                  20) Other: \_\_\_\_\_ .

## **DETAILED ACTION**

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

I. Claims 1-14, 21, and 17-20, drawn to ligand profiles characteristic of a given cell, methods of generating such ligand profiles and methods of using same for comparing a first cell sample to a reference cell sample.

II. Claims 15-16, drawn to a subtraction profile of polypeptide ligands and method of generating same.

III. Claims 22-25, essentially drawn to methods of using ligand profiles for detecting a difference between the set of proteins expressed in a first cell and the set of proteins in a second cell.

IV. Claims 26-34, drawn to databases stored on machine-readable medium.

V. Claims 35-42, essentially drawn to methods of using ligand profiles and databases of Group IV.

The inventions listed as Groups I-V do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or

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corresponding special technical features for the following reasons: Group I encompasses ligand profiles characteristic of a given cell and methods of generating same, as well as the first method of use of this subject matter. Group II is directed to a different special technical feature: a subtraction profile of polypeptide ligands and the unique method of making such. Group III is directed to methods of using ligand profiles for detecting a difference between the set of proteins expressed in a first cell and the set of proteins in a second cell. Detection of differences in protein expressed in a cell versus a reference cell is an important field both in basic biological and biomedical research as well as in clinical studies. Therefore, the special technical feature in these uses of ligand profile is not the ligand profile per se, but the whole process with focus on the results of the process, i.e. the actual differences in protein expression. Group IV is directed to databases stored on machine-readable medium with clearly its own special technical feature obviously different from those of Groups I-III and V. Group V is directed to methods of using ligand profiles and databases of Group IV. The special technical feature in these methods is the combined application of ligand profiles and databases. Consequently, due to the different inventive concepts and technical features among the above five Groups of inventions, they are usually published separately in literature. Thus, in summary, each of Groups I-V is directed to different special technical feature and thus support this lack of unity among all the inventions in the instant application and restriction for examination purposes as indicated is proper

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR § 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to:

Shubo "Joe" Zhou, Ph.D., whose telephone number is (703) 605-1158. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is 703)-305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

S. "Joe" Zhou: sjz/*sjz*

December 6, 2000

*Ardin H. Marschel*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER